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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,640	02/13/2002	Michael Nuttall	500803.02	9841

7590

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EXAMINER

VU, DAVID

ART UNIT

PAPER NUMBER

2818

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,640

Applicant(s)

NUTTALL ET AL.

Examiner

DAVID VU

Art Unit

2818

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/13/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 30-46 and 49 are rejected under 35 U. S. C. 102(b) as being anticipated by Tseng (US 5,854,105).

Regarding claims 30-32, 38-40, 45-46 and 49, Tseng, in related text (Col. 3, Lines 48-58; Col. 4, Line 23 - Col. 5, Line 54) and figures (Figs. 1-2) discloses an integrated circuit comprising a semiconductor substrate 10 including a plurality of transistors, each transistor including a pair of doped regions 19 formed within the substrate and having a channel region defined between the doped regions, and each transistor including a control stack formed over the channel region, the integrated circuit including contacts selectively 26 formed on each doped region.

Regarding claim 33, wherein the control stack of each MOS transistor comprises a gate stack including an oxide layer 14, polysilicon layer 16, silicide layer 16, another oxide layer 18, and a nitride layer 22 (Fig. 1 and Col. 4, Line 23-Col. 5, Line 43)

Regarding claim 37, wherein an insulating spacer layer 20/22 is disposed between the control stack and the contacts (Fig. 1).

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Regarding claims 34-36 and 41-44, the limitation "while each contact is being selectively formed, the contact being heated to increase a vertical growth rate of the contact relative to a horizontal growth rate of the contact so that each contact has a height greater than or equal to a height of the control stack while being isolated from an adjacent contact being formed on a doped region of an adjacent transistor" in claims 30 and 38, "wherein the contact is heated by illuminating an upper surface of the contact with electromagnetic radiation" in claims 34 and 41, "wherein the electromagnetic radiation comprises collimated light" in claims 35 and 42, "wherein the collimated light comprises a scanning laser beam" in claims 36 and 43-44, are taken to be a product by process limitation and consider non-limitation. In a product-by-process claim, it is the patentability of the claimed product and not of the recited process steps which must be established. Therefore, when the prior art discloses a product which reasonably appears to be identical with or only slightly different than the product claimed in a product-by-process claim, a rejection based on sections 102 or 103 is fair. The Patent Office is not equipped to manufacture products by a myriad of processes put before it and then obtain prior art product and make physical comparisons therewith. In *re Brown*, 173 USPQ 685 (CCPA 1972). Also, a product by process claim directed to the product per se, no matter how actually made, In *re Hirao*, 190 USPQ 1 S at 17 (footnote 3). See In *re Fessman*, 180 USPQ 324, 326 (CCPA 1974); In *re Marosi et al.*, 218 USPQ 289, 292 (Fed. Cir. 1983); and particularly In *re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), all of which make it clear that it is the patentability of the final structure of the product "gleaned" from the process steps, which must be determined in a "product by process" claim, and not the patentability of the process. See also MPEP 2113. Moreover, an old and obvious

product produced by a new method is not a patentable product, whether claimed in "product by process" claims or not.

Note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Fessmann, 180 USPQ 324; In re Avery, 186 USPQ 161; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Marosi et al, 218 USPQ 289; and particularly In re Thorpe, 227 USPQ 964, all of which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that applicant has the burden of proof in such cases, as the above caselaw makes clear.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 48-48 and 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tseng (US 5,854,105) in view of White, Jr. et al., (US 6,130,102).

Tseng discloses all claimed subject matter, but fails to expressly mention the substrate comprises silicon germanium or gallium arsenide.

White, Jr. et al., in related text (Col. 3, Lines 26-31) disclose the substrate comprises silicon germanium or gallium arsenide. It would have been obvious to one of ordinary skill in the art at the time the invention was made for using the substrate materials as taught by White, Jr. et al., within the general skill of a worker in the art, to select a known material on the basis of its suitability for its intended use is a matter of obvious design choice.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Vu whose telephone number is (703) 305-0391. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm. If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Nelms., can be reached on (703) 308-4910.

DV
David Vu.


David Nelms
Supervisory Patent Examiner
Technology Center 2800